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EXAMINER

AUGHENBAUGH, WALTER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENNIS E. SMITH,
TEH-MING KUNG,
THOMAS M. LANEY, and
JOHN L. MUEHLBAUER

Appeal 2008-4702
Application 10/033,457
Technology Center 1700

Decided:¹ June 18, 2009

Before BRADLEY R. GARRIS, PETER F. KRATZ and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

COLAIANNI, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

This is in response to a Request, filed May 8, 2009, for rehearing of our decision, decided March 10, 2009, wherein we sustained the § 102 and § 103 rejections on appeal. Particularly of relevance, we sustained a § 102 rejection of claims 1, 2, 5, 7, 9-17, 21, 22, 24-26, 28-36, and 39 over Maier, and a § 103 rejection of claims 18, 19, 37, and 38 over Maier.

Appellants argue that the Board misapprehended Appellants' argument on page 13 of the Brief (Request 1). Specifically, Appellants contend that they argued not that the 95/5 methylmethacrylate/divinylbenzene composition itself would not have such a low Δb^* value, but rather that the claimed properties are not inherent because the Δb^* value may or may not be less than 0.2 for various compositions that fall within the broad description of suitable materials described in Maier (Request 1-2).

Appellants further contend that the Board's position that the Δb^* value can be inferred from Maier's disclosure is inconsistent with its treatment of Appellants' reliance on trends in Maier's data to show that Maier does not teach the claimed thermal stability (Request 2).

Contrary to Appellants' arguments, we did not misapprehend Appellants' argument or take inconsistent positions. Rather, we posit that since Maier's disclosure of a 95/5 methylmethacrylate/divinylbenzene composition is the same as Appellants' claimed composition, Maier's composition would inherently have the same Δb^* value claimed by Appellants. Our position is supported by *In re Best*, 562 F.2d 1252 (CCPA 1977), where the court held that where the claimed and prior art products are substantially identical, the Patent Office can require an applicant to prove

that the prior art products do not necessarily or inherently possess the characteristics of the claimed product. *Best*, 562 F.2d at 1255.

Therefore, we are not extrapolating a Δb^* value based on a trend in the data as Appellants have done in an attempt to establish that Maier's composition does not possess the thermal stability property. Instead, we rely on the similarity of the compositions as providing a basis for finding that the claimed properties are inherently part of the composition such that Appellants have the burden of establishing that Maier's 95/5 methylmethacrylate/divinylbenzene composition does not possess the claimed characteristics. However, Appellants' data only provides data for 70/30 and 90/10 methylmethacrylate/divinylbenzene compositions. Appellants have not satisfied their burden of establishing that Maier's 95/5 methylmethacrylate/divinylbenzene composition does not possess the claimed non-yellowing and thermal stability properties.

With regard to the § 103 rejection of claims 18, 19, 37, and 38, Appellants further argue that the Board overlooked the added requirement that the second polymer is derived from monomers comprising more than 20 wt% of crosslinking monomer (Request 3). Appellants contend that the Examiner and Appellants noted that Maier fails to teach such requirement on page 15 of the Appeal Brief (Request 3).

Our review of page 15 of the Appeal Brief reveals that Appellants merely reiterated the Examiner's statement of the rejection on that page. Appellants' arguments regarding dependent claims 18, 19, 37, and 38 do not begin until page 17 of the Appeal Brief, where Appellants argue the previously argued features of independent claims 1 and 21 from which claims 18 and 19, and claims 37 and 38 depend, respectively.

Therefore, Appellants argue for the first time in this appeal the “20 wt% crosslinking monomer” feature of the dependent claims 18, 19, 37, and 38. In accordance with 37 C.F.R. § 41.52 because such a new argument is not made regarding a “recent relevant decision of the Board or a Federal Court” or in response to a new grounds of rejection under § 41.50(b), Appellants’ newly advanced argument has not been considered.

Appellants contend that the Board misapprehended or overlooked Appellants’ arguments that the secondary references are directed towards different fields (Request 4). Appellants quote from their Appeal Brief where they contend that Saito does not teach the features that Examiner finds Maier to disclose (Request 4), as evincing an argument that Saito is from a different field. However, this apparent non-analogous art argument is raised for the first time in this Request. In accordance with 37 C.F.R. § 41.52 because such a new argument is not made regarding a “recent relevant decision of the Board or a Federal Court” or in response to a new grounds of rejection under § 41.50(b), Appellants’ newly advanced argument has not been considered.

Moreover, Appellants’ arguments that the secondary references, like Saito, fail to teach the various features of the independent claims were considered. Because we found that Maier was not deficient with regard to any of the features in the independent claims, we determined that Appellants’ arguments regarding these secondary references to be without persuasive merit.

Appellants argue that the Board overlooked that Maier’s disclosure regarding the thermal and chemical stability of the synthetic paper was based on alleged properties, not actual data

(Request 4). However, Maier's statements plainly indicate that Maier's disclosed invention provides superior thermal and chemical stability properties. Appellants have not provided any evidence that Maier's 95/5 methylmethacrylate/divinylbenzene composition would not have the claimed properties. Appellants' evidence regarding the yellowing property and thermal stability are limited to 70/30 methylmethacrylate/divinylbenzene compositions of Maier. We have thoroughly reviewed Appellants' submitted evidence and find it insufficient to rebut the Examiner's prima facie cases of obviousness for the reasons given on page 17 of the Decision.

For the above stated reasons, we adhere to our determination that claims 1, 2, 5, 7, 9-17, 21, 22, 24-26, 28-36, and 39 are anticipated by Maier under § 102(b), and that claims 18, 19, 37, and 38 over Maier, claims 8 and 27 over Maier in view of Saito, claim 40 over Maier in view of Hart, and claims 42 and 43 over Maier in view of Harrison would have been obvious under § 103.

The Request for Rehearing is denied.

DENIED

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